



(3)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 122.1.1/USA

In re Application of:)
John L. Shannon, Jr.)
Serial No. 09/655,054)
Filed September 5, 2000) Group Art Unit 3711
For TELESCOPIC SINGLES) Examiner A. Hunter
STICK)

RECEIVED

JUL 14 2003

TECHNOLOGY CENTER R3700

APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

The Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is Appellant's brief in this patent application.

REAL PARTY IN INTEREST

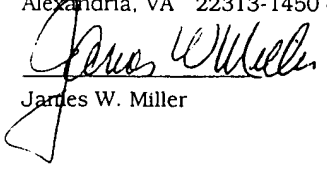
The Applicant, John L. Shannon, Jr., an individual inventor, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

Page - 1 -

Certificate under 37 C.F.R. 1.8. I hereby certify that this correspondence is being deposited with sufficient postage with the U.S. Postal Service, as First Class Mail, in an envelope addressed to: Mail Stop Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 7/5/03.


James W. Miller

STATUS OF CLAIMS

Claims 1-26 are canceled.

Eight claims are at issue comprising claims 27-34. The Appendix to this brief contains the current amended form of claims 27-34. Claims 27-34 all stand rejected by the Examiner under 35 U.S.C. § 102(b) or 103.

STATUS OF AMENDMENTS

No Amendments After Final Rejection were filed in this application.

SUMMARY OF THE INVENTION

This invention relates to a singles stick for adjusting the height of a tennis net to conform the net to regulation singles play. Most tennis nets on most tennis courts are configured for doubles play, not for singles play. Accordingly, the height of such a "doubles play" tennis net as the net crosses the singles lines is too low for regulation singles play. In the past, singles sticks have been wedged beneath the net between the singles and doubles lines. The singles stick has a height that is chosen so that the singles stick when in place raises the height of the net as it crosses the singles lines so that the net will have precisely the height above the ground that is needed for regulation singles play.

In the past, singles sticks have typically been one piece. Consequently, the typical singles stick is too long to fit into the equipment bags carried by tennis players to transport their rackets, tennis balls, and the like. As a

result, many tennis players do not bother to carry singles sticks with them and must find a pair of singles sticks at the court if they want to play regulation singles tennis. If they cannot find a pair of singles sticks to use, they are reduced to playing on a court in which the net is too low to conform to regulation singles tennis play.

The singles stick 20 of this invention comprises a telescopic base 22 and staff 24 that can be pulled out into a single, extended and locked position or can be collapsed into a single, collapsed and locked position. Staff 24 carries spaced holes 36a and 36b that cooperate with a locking pin 32 for locking base 22 and staff 24 together in the single extended position or in the single collapsed position. In the single extended position shown in Fig. 1, the singles stick has just the right height to raise the tennis net by the amount needed to conform the net to regulation singles play. In the single collapsed position shown in Fig. 2, the singles stick is short enough to be carried in a tennis player's equipment bag.

The singles stick of this invention is easy to use and can be quickly installed. All the user need do is to pull the base and staff apart until they lock together in **the single, predetermined, extended and locked position** that is provided therefor. Significantly, the user does not need to measure the length of the singles stick since the single, predetermined, extended and locked position sets the length of the stick at just the right amount considering the vertical location the bottom of the notch 29 has relative to the ground in this position.

Moreover, the user need not figure out which of various possible extended and locked positions should be used since only a single, predetermined, extended and locked position is provided. The user simply puts the stick in the only ex-

tended and locked position that is provided. In this position, the singles stick 20 will have just the right length.

ISSUES

The issues presented in this appeal are whether claims 27-32 are unpatentable under 35 U.S.C. § 102 in view of U.S. Patent 5,665,038 to Miller and whether claims 27-34 are unpatentable under 35 U.S.C. § 103 in view of U.S. Patent 4,976,432 to Cheney as modified by U.S. Patent 5,352,057 to Zody.

GROUPING OF CLAIMS

Claims 27-34 stand or fall together.

ARGUMENT

The Anticipation Rejection Based Upon Miller

The reference to Miller has nothing to do with tennis or a singles stick for adjusting the height of a tennis net. It relates to an exercise bench for weight lifting. The only possible relevance that Miller has is its showing of telescoping weight supports 20 that can be locked into a plurality of different heights.

The Examiner has used Miller arguing that Miller has the same structure as that claimed in this application. However, claim 27 is to a singles stick, not to an exercise bench or to a telescopic weight support on an exercise bench. Thus, Miller does not disclose the "singles stick" that is claimed. The reference to a singles stick and to use with a tennis net is not simply in the preamble of claim

27, but is spread throughout the substantive limitations of claim 27.

As a further example of how wrong the 102 rejection is, limitation (d) of claim 27 requires a lock "configured to hold the base and staff in a single, predetermined, extended and locked position." According to the Random House Dictionary of the English Language, College Edition, the word "single" means "one only; only one in number; sole". Yet, the telescopic weight support 20 in Miller clearly has a plurality of holes (unnumbered) along its length so that the weight support can be locked in a plurality of different extended and locked positions. How can something that provides a plurality of positions read on a limitation that calls for a single position? It can't. Note that Claim 27 does not call for at least one position, or a position, but a single position. Miller's weight supports 20 simply are NOT supports that can be locked in a single, predetermined, extended and locked position.

Claim 27 then goes on to carefully define how long the singles stick must be in its single, predetermined, extended and locked position. Limitation (e) sets forth the length as follows:

"...wherein the combined length of the base and staff in the single, predetermined, extended and locked position of the base and staff is selected to hold the top edge of the tennis net above the ground by an amount required to conform the tennis net for regulation singles play when the singles stick is installed at a predetermined court location between a singles line and doubles line on one side of a tennis court...".

Where in Miller is there any teaching, however remote, that the telescopic weight supports when locked have just the right height to "hold the top edge of the tennis net above the ground by an amount required to conform the tennis

net for regulation singles play when the singles stick is installed at a predetermined court location between a singles line and doubles line on one side of a tennis court"? There is no such teaching. Miller does not even state how high his weight supports will be above the ground in any of their different positions. Miller certainly does not state that the weight supports 20 when locked in a particular position will lift a tennis net into a height suitable for regulation singles play if somehow one could even wedge his exercise bench beneath a tennis net. This total lack of the required height set forth in limitation (e) of claim 27 is further proof of how tenuous and unsupported the Examiner's anticipation rejection really is.

For these reasons, the Examiner's rejection of claims 27-32 as being anticipated by Miller is in error and should be reversed.

The Obviousness Rejection Based Upon Cheney and Zody

Cheney is the only reference used by the Examiner in his rejections that shows a singles stick. In Cheney, a singles stick can be assembled for use by sticking together a plurality of sections 18 and 26 in an end to end manner. See Figs. 2-4. Each lower section 26 has a dowel 22 that fits into a hollow lower end 30 of an adjacent upper section. While Cheney discloses that methods of connecting the separate sections together other than dowels 22 could be used (See Col. 6 of Cheney, Lines 45-49), Cheney never discloses any alternatives to the basic end to end connection of a plurality of separate sections.

The top section of Cheney's singles stick is provided with a notch having an adjustable depth as determined by the vertical position of peg 12. See Figs. 5-7 of Cheney which

show the five different holes 16 in which peg 12 can potentially be received. Thus, Cheney's singles stick, even when adjusted, could have different effective heights depending upon which hole 16 receives peg 12.

The patent to Zody is directed to an adjustable track hurdle. Much like Miller, it shows a height adjustable member 15 that can be locked in one of many different extended positions depending upon which hole 26a, 26b or 26c receives the locking pin 18. See Fig. 5 of Zody. It is not a singles stick. It does not disclose a single, predetermined, extended and locked position for member 15.

The Examiner's attempted 35 USC 103 combination of Cheney and Zody must fail for two reasons.

First, there is no suggestion or teaching in the art for adjusting the height of Cheney's singles stick by making it telescope in and out. All Cheney discloses is a plurality of separate sections that are joined end to end. Cheney does not disclose or suggest any type of telescopic connection between the sections. Whenever Cheney describes alternatives, he is simply describing alternatives for how one could join the end to end sections together by suggesting that dowels 22 are not the only way to do so. He is not suggesting that the end to end connection of the sections be dropped in favor of a totally different approach such as a telescopic approach.

Secondly, even if one were to try and use a telescopic approach with Cheney, the fact that pin 19 can be adjusted would inherently require that the singles sticks have a plurality of extended and locked positions. In other words, with peg 12 in the middle hole 16 as shown in Figs. 10-12 of Cheney, Cheney's singles stick would have to be locked in a first, extended and locked position that was chosen so that the height of the peg 12 was precisely the right amount

above the ground to provide regulation singles play. If the peg 12 in Cheney is moved to any other hole 16, the extended length chosen for the singles stick with peg 12 in middle hole 16 would no longer be correct. For example, if the peg 12 were moved to a lower hole 16, the tennis net would now be too low and if the peg 12 were moved to a higher hole 16 the tennis net would be too high. The only way in Cheney to keep the tennis net height correct would be to provide a plurality of extended and locked positions for the singles stick, namely five such different extended and locked positions, corresponding to the five holes 16 shown in the top section 18 of Cheney's singles stick.

One must keep in mind that claim 27 is directed to a singles stick having a fixed depth notch at the top as required in limitation (b) which states "a fixed depth notch on top of the staff". Thus, when the singles stick is pulled out and placed into its single, predetermined, extended and locked position, the height of the singles stick in relation to the bottom of this fixed depth notch will be just right to conform the net to regulation singles play. Cheney teaches away from a singles stick having a fixed depth notch cooperating with a single, predetermined, extended and locked position as Cheney specifically shows an adjustable depth notch.

The secondary reference to Zody showing a height adjustable track hurdle does nothing to supply what Cheney lacks. Zody has many different extended and locked positions due to the large number of adjustment holes 26a, 26b, 26c provided. To find a particular desired position, the user would have to pay attention to which holes are being used and/or would have to measure. Zody certainly does not teach a single, extended and locked position chosen with respect to the bottom of a fixed depth notch.

As presented herein, claim 27 is directed to the ease of use provided by the Applicant's invention, namely to an extensible and collapsible singles stick having a fixed depth notch and a single, extended and locked position chosen with respect to this notch. In this invention, the user simply pulls the base and staff apart until the single, predetermined, extended and locked position is reached and the user knows the stick will have just the right height when the top support cord or cable rests within the notch to position the net for singles play.

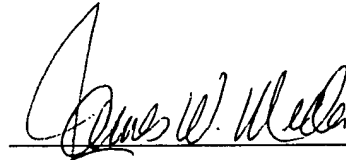
For these reasons, the Examiner's rejection of claims 27-34 as being obvious in view of Cheney as modified by Zody is also in error and should be reversed.

SUMMARY

As detailed above, the Examiner's basic 35 U.S.C. § 102 and 103 rejections of Claims 27-34 should be reversed. The Examiner fails to properly construe the claims which limit themselves to a singles stick having a single, predetermined, extended and locked position. When the singles stick is placed in this position, the length of the base and staff is just right to conform the net to singles play when a fixed depth notch is used at the top of the staff.

This structure is not anticipated by the height adjustable weight supports 20 of Miller which have a plurality of different extended and locked positions and are not singles sticks. Moreover, even if one improperly tries to make Cheney into a telescopic singles stick, rather than one that is assembled end to end from separate sections, Cheney does not have a fixed depth notch and would not be height adjustable using a single, predetermined, extended and locked position.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "James W. Miller", is written over a horizontal line.

July 5, 2003

James W. Miller
Registration No. 27,661
Suite 1005
Foshay Tower
821 Marquette Avenue
Minneapolis, MN 55402

Telephone (612) 338-5915

APPENDIX

27. A singles stick for holding the top edge of a tennis net at its regulation height above the ground for singles play, which comprises:

- (a) a base having a bottom for engaging the ground;
- (b) a staff slidably connected to the base such that the base and staff can be pulled apart or pushed together between collapsed and extended positions thereof by sliding the base and staff relative to one another;
- (c) a fixed depth notch on top of the staff with the notch having an upwardly facing bottom, wherein a top support cord or cable of a tennis net can be placed within the notch and when so placed the top support cord or cable rests against and is retained against vertical movement by the bottom of the notch;
- (d) a lock which releasably secures the base and staff against sliding movement relative to one another when the lock is engaged, wherein the lock is configured to hold the base and staff in a single, predetermined, extended and locked position; and
- (e) wherein the combined length of the base and staff in the single, predetermined, extended and locked position of the base and staff is selected to hold the top edge of the tennis net above the ground by an amount required to conform the tennis net for regulation singles play when the singles stick is installed at a predetermined court location between a singles line and doubles line on one side of a tennis court, wherein a user can quickly and easily conform one side of the tennis net for regulation singles play without measurement by pulling the base and staff of the singles stick apart, by locking the base and staff of the

singles stick together in the single, predetermined, extended and locked position that is provided therefor, and by then wedging the singles stick between the top support cord or cable and the ground at the predetermined court location, the singles stick when so wedged having the top cord or cable of the tennis net resting against the bottom of the notch on the staff with the bottom of the base resting against the ground.

28. The singles stick of claim 27, wherein the base and staff are telescopically connected to one another.

29. The singles stick of claim 28, wherein the base and staff have mating non-circular cross-sectional configurations.

30. The singles stick of claim 27, wherein the bottom of the base comprises an enlarged foot for abutting against the ground.

31. The singles stick of claim 27, wherein the lock is further configured to hold the base and staff in a single, predetermined, collapsed and locked position.

32. The singles stick of claim 27, wherein the lock comprises a locking pin insertable in a hole when the lock is engaged.

33. The singles stick of claim 32, wherein the pin is spring biased in a direction tending to insert the pin in the hole when the pin is aligned with the hole.

34. The singles stick of claim 27, wherein the lock is biased towards automatic engagement of the lock.